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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                      | CONFIRMATION NO. |
| 10/534,524   | 01/04/2006  | Tetsuji Kito         | 271771US0PCT                             | 5201             |
| 22850  | 7590        | 07/24/2009           |  |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>CHANNAVAJALA, LAKSHMI SARADA |                  |
|  |             |                      | ART UNIT                                 | PAPER NUMBER     |
|  |             |                      | 1611                                     |                  |
|  |             |                      | NOTIFICATION DATE                        | DELIVERY MODE    |
|  |             |                      | 07/24/2009                               | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |   |                                    |  |
|------------------------------|---|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/534,524        | <b>Applicant(s)</b><br>KITO ET AL. |  |
|                              | <b>Examiner</b><br>Lakshmi S. Channavajjala | <b>Art Unit</b><br>1611            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Receipt of amendment and response dated 3-4-09 is acknowledged.

New claim 10-19 have been added. Claims 1-19 are pending.

In response to the amendment and persuasive arguments, the rejection of record has been withdrawn and the following new rejection has been applied:

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, 17, 22-28, 30-41, 43 and 45-49 of copending Application No. 10/534753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are directed to a cosmetic composition, comprising: surface-hydrophobated water-absorbing polymer particles, and an anti-perspiring component,

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wherein the surface-hydrophobated water-absorbing polymer particles comprise water-absorbing polymer particles coated thereon with a silicone compound having at least one kind of functional group, wherein the silicone compound is chemically bonded to the surface of the surface-hydrophobated water-absorbing polymer particles, and wherein the average particle diameter of the surface-hydrophobated water-absorbing polymer particles is 0.1 to less than 10 p.m. Instant claims also claim a cosmetic composition comprising a surface-hydrophobated water-absorbing polymer particles. Instant polymer particles have the same crosslinked polymeric materials that are also coated with silicone compounds as that of the copending claims, with the particle sizes and water absorbing capacity overlap with the instant claims. Instant as well as the copending polymer particles are also employed in the same type of composition i.e., antiperspirant. Instant coating silicones and the particles sizes of the hydrophobated polymers are anticipated by the hydrophobated polymers of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-8, 10-17 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-24 of copending Application No. 10/137405. Although the conflicting claims are not identical, they are not patentably distinct from each other. The copending claims are directed to silicone modified water absorbing polymer particles wherein the particle size range between 1-50 microns, a cosmetic comprising said particles and a method of producing

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the same. The dependent claims of the copending application also recite that the particle is a crosslinked copolymer of hydrophilic vinyl monomer. The scope of the instant claims and the copending claims is overlapping because while instant claim 1 does not specify the surface modifying substance as silicone and also the particle size, dependent claims of the instant application recite that the coating material is a silicone compound and the same particle size of the copending claims. The copending claims recite several polymer materials that can make up the polymer particles and therefore anticipate instant generic polymer and accordingly, the water absorbing capacity, water content etc., because the polymers and the surface coating materials of the copending application are also claimed in the dependent claims. Instant coating silicones and the particles sizes of the hydrophobated polymers are anticipated by the hydrophobated polymers of the copending claims.

4. Claims 1-8, 10-17 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-24 of copending Application No. 10/137405 in view of Otsuka (JP05070322-, translation provided).

5. With respect to emulsion and antiperspirant, the copending claims recite a cosmetic composition and not an emulsion or an antiperspirant method of instant claims.

Otsuka discloses a water in oil emulsion cosmetic characterized by comprising 0.1-10% by weight of a water absorbing polymer and 1-20% by weight of a dimethylpolysiloxane (abstract). The water absorbing polymer can include carrageenan,

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gelatin, agar, tragacanth gum, viscose, methylcellulose, ethylcellulose, hydroxyethylcellulose, carboxymethylcellulose, polyvinyl alcohol or the like by adding a polyvalent metal salt (paragraph 0009). Other examples include methacrylic acid, acrylic acid, a salt of ammonium, acrylamide, and VPV, for example (paragraphs 0010-0012). The hydrophobized powder is obtained by subjecting one or more types of powder to a hydrophobization treatment. Agents are preferably silicone oils, such as dimethylpolysiloxane, methyphenylpolysiloxane, methyhydrogenpolysiloxane, and the like (paragraph 0022). Cyclic polysiloxane can also be used (paragraph 0033). The oil agent may be present in the amount of 0.1-20% by weight (paragraph 0024). The average particle size is 0.05-50um (paragraph 0023). Water can be present in an arbitrary amount, in order to provide a good usability, less oily feeling or sticky feeling, and to improve spread ability. It is usually present in the amount of 10% or more (paragraph 0025). In the emulsion, an antiperspirant substance can be blended within the range that does not impair the effect of the composition. Any substance can be used as long as it is a substance conventionally considered to have an antiperspirant action, for example an astringent salt aluminum or zirconium. The antiperspirant is present in the amount of 1-50% by weight (paragraph 0026).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a cosmetic composition of the copending claims in the form of an emulsion and further comprising antiperspirant compounds because Otsuka suggests that the compositions comprising water absorbing polymers in

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the cosmetic does not give a frictional feeling caused by sweating and is therefore employed in antiperspirant compositions {0002, 0004}.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 7-11 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Otsuka (JP05070322, translation provided).

Otsuka discloses a water in oil emulsion cosmetic characterized by comprising 0.1-10% by weight of a water absorbing polymer and 1-20% by weight of a dimethylpolysiloxane (abstract). The water absorbing polymer can include carrageenan, gelatin, agar, tragacanth gum, viscose, methylcellulose, ethylcellulose, hydroxyethylcellulose, carboxymethylcellulose, polyvinyl alcohol or the like by adding a polyvalent metal salt (paragraph 0009). Other examples include methacrylic acid, acrylic acid, a salt of ammonium, acrylamide, and VPV, for example (paragraphs 0010-0012), which includes crosslinked polymers and hence meet the claimed limitations. The hydrophobized powder is obtained by subjecting one or more types of powder to a hydrophobization treatment. Agents are preferably silicone oils, such as dimethylpolysiloxane, methyphenylpolysiloxane, methyhydrogenpolysiloxane, and the like (paragraph 0022). Thus, the description of Otsuka reads on instant silicone treated polymers Cyclic polysiloxane can also be used (paragraph 0033). The oil agent may be

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present in the amount of 0.1-20% by weight (paragraph 0024). The average particle size is 0.05-50um (paragraph 0023), reads on instant claim 2. Otsuka teaches that the composition is used as an antiperspirant (0002 and 0022) and hence reads on instant antiperspirant and hence the claimed method. In the emulsion, an antiperspirant substance is be blended within the range that does not impair the effect of the composition. Any substance can be used as long as it is a substance conventionally considered to have an antiperspirant action, for example an astringent salt aluminum or zirconium. The antiperspirant is present in the amount of 1-50% by weight (paragraph 0026). Hence, Otsuka anticipates instant claims.

### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 3-6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka (JP05070322, translation provided).
10. Otsuka described above fails to explicitly teach the amount of water absorbed, water content and the viscosity of the composition. The reference also fails to specifically teach a composition with a silicone coated polymer. However, Otsuka teaches that the hydrophobized powder is obtained by subjecting one or more types of powder to a hydrophobization treatment. Agents are preferably silicone oils, such as dimethylpolysiloxane, methyphenylpolysiloxane, methyhydrogenpolysiloxane, and the



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like (paragraph 0022). Thus, the description of Otsuka reads on instant silicone treated polymers cyclic polysiloxane can also be used (paragraph 0033). Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention was made to employ silicone for surface treatment of the water absorbing polymers and still expect the advantages in terms of reduced frictional feeling and long lasting effect because Otsuka suggests hydrophobized powder for improving the reduction of stickiness even further. Otsuka suggests silicones such as methylphenylsilicone and therefore reads on instant silicone with functional group.

11. For the claimed water, Otsuka suggests can be present in an arbitrary amount, in order to provide a good usability, less oily feeling or sticky feeling, and to improve spread ability. It is usually present in the amount of 10% or more (paragraph 0025) and therefore a skilled artisan would have been able to employ the desired amount of water such that the usability and reduced stickiness is not compromised.

While Otsuka does not explicitly state the amount of water absorbed or the viscosity of the composition, Otsuka teaches the same components claimed and in the same particle size and also the amounts and therefore it is the position of the office that one skilled in the art would expect that the higher amounts of water in the composition renders high amount of water absorbed and also higher viscosity. In this regard, Otsuka suggests liquid absorption amount of 2 or more (0013).

12. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masashi et al. (AU-B-25757/95) in view of Otsuka (JP05070322, translation provided).

Masashi discloses water absorbent resin particles comprising water absorbent resin particles (A) which are a cross linked polymer of ethylenically unsaturated monomers comprising acrylic acid and/or acrylic acid salt as an essential element, treated with an organic polysiloxane (B), wherein (A) and (B) are mixed and/or reacted, the particles have a particle size of 10-1000um and the weight ratio of (A)/(B) is 100/(0.001-5) (abstract). Masashi further discloses since the surface of (A) particles is improved with (B) liquid organic polysiloxane, the water absorbent resin particles have an improved hygroscopic blocking rate in a high humidity and obtain a wettability to prevent the generation of dust. Additionally, since the conventional disadvantage of disturbing uniform penetration of water caused by bonding of water-absorbent particles each other is improved by the modification effect of (B) in this invention, the absorption rate is improved. Examples of such water-absorbent resins (A) include cross linked partially neutralized polyacrylic acid, self-cross linked partially neutralized polyacrylic acid, cross linked graft-copolymers of starch-acrylic acid salt, hydrolyzed cross linked graft- polymers of starch-acrylonitrile, cross linked copolymers of vinyl alcohol-acrylic acid salt, hydrolyzed cross linked copolymers of acrylic acid-acrylamide, hydrolyzed cross linked copolymers of acrylic acid salt-acrylonitrile, cross linked copolymers of acrylic acid salt and 2-acrylamide-2-methyl propane sulfonate, neutralized cross linked copolymers of isobutylene-maleic anhydride, and mixture of two or more of these examples (page 7, 2nd paragraph). In the case when the above cross linked polymers shown are examples of water absorbent resins (A) are formed with carboxylic salts such as acrylic salt as a raw material, or when they form salts as a neutralized product or a

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partially neutralized product, examples of such salts include sodium salt, potassium salt, ammonium salt, and amine salt (page 7, last paragraph through page 8, top paragraph). Preferable organic polysiloxane compounds include amino-modified silicone oil such as the amino-modified silicone oil (see page 11 chemical structures). Since Masashi teaches the same polymer particles claimed in the instant application, absent a showing to the contrary, it is the position of the examiner that the particles would have the same functional limitations of claims 3-4 and 12-13.

While Masahi fails to exemplify a cosmetic emulsion and hence an antiperspirant composition and method claimed, Masahi teaches the particles may be admixed with fillers or additives including organic powders, natural polysaccharides, inorganic powders, including alumina, antioxidants, antiseptic agents, disinfectants, surface active agents, coloring agents, perfumes and deodorants (page 21, top paragraph).

The teachings of Otsuka have been discussed above. Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention was made to use the water absorbing polymers particles of Masahi in cosmetic emulsion formulations, particularly, in antiperspirant formulations, because Otsuka suggests that the surface hydrophobized water absorbing polymer particles are very effective in reducing the sticky feeling observed with sweating and also imparts a long lasting effect in a cosmetic composition comprising cosmetic ingredients such as antiperspirants. A skilled artisan would have expected to achieve the above benefits with appropriate amounts of the polymer particles of Masahi.

No claims allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611  
July 20, 2009